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09/444,774	11/22/1999	MICHAEL G MIKURAK		9073

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EXAMINER

DURAN, ARTHUR D

ART UNIT PAPER NUMBER

3622

DATE MAILED: 08/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/444,774

Applicant(s)

MIKURAK, MICHAEL G

Examiner

Arthur Duran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 70-86 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 70-86 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8, 12
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

1. Claims 70-86 have been examined.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/18/03 has been entered.

Response to Amendment

3. The Amendment filed on 7/18/03 is sufficient to overcome the Abgrall and Gerace reference.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 70-84, 86 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. These claims are rejected under 35 U.S.C. 101 because these claims have no connection to the technological arts. The method claims do not specify how the claims utilize any technological arts. For example, no network or server is specified as

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being utilized. While the claims disclose that the first business uses a network, the claims do not specify that a network, or any other medium in the technological arts, is being utilized for the method steps disclosed in the claims. To overcome this rejection, the Examiner recommends that the Applicant amend the claim to specify or to better clarify that the method is utilizing a medium or apparatus, etc within the technological arts. Appropriate correction is required.

As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the

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invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. *In re Toma* at 857.

In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.*, the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be

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based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma*. However, *State Street* never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a §101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

In the current application, no technological art (i.e., computer, network, server) is being utilized by claims 70-84, 86. Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a

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whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 70-81 are rejected under 35 U.S.C. 103(a) as being unpatentable over Webber (6,167,378).

Claim 70: Webber discloses a method for a first business entity to provide installation management in a networkbased supply chain framework between at least two other independent business entities such as service providers, vendors, resellers, manufacturers and the like, comprising:

causing a first business entity using a network to (col 6, lines 13-24; Fig. 4; col 19, lines 9-26):

- (a) receive information including information relating to a service provided by a service provider from the service provider (col 6, lines 60-67; Fig. 4; col 1, lines 12-17; col 19, lines 9-26);
- (b) receive information including information relating to manufacturer offerings by a manufacturer from the manufacturer (col 6, lines 60-67; Fig. 4; col 19, lines 9-26);
- (c) use the information provided by the service provider and the manufacturer to match the service to the offerings (col 6, lines 62-64; Fig. 4; col 2, lines 34-36; col 8, line 65-col 9, line 17; col 9, lines 47-52; col 19, lines 9-26).

Webber does not explicitly disclose that the service and manufacturer offerings information is utilized to manage installations.

However, Webber discloses installations (col 16, lines 20-25) computer service providers (col 6, lines 13-23) and that the information can be utilized to manage a wide range of relations between manufacturers, service providers, and clients (col 19, lines 9-26; col 3, lines 60-65; col 14, lines 48-54; col 17, lines 24-31).

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Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to that Webber's contracts management matching and managing method can involve contracts involving installation management. One would have been motivated to do this because installation management is an obvious form of contracts managements that involves several parties.

Claim 71: Webber discloses a method as recited in claim 70, and further discloses the first business entity using the network to:
manage collaboration between the matched service provider and the manufacturer by facilitating the transmitting of information between the matched service provider and the manufacturer (col 19, lines 9-26).

Claim 72: Webber discloses a method as recited in claim 71, and further discloses the first business entity using the network to:
provide a collaborative planning tool for managing the collaboration between the matched service provider and the manufacturer (col 19, lines 9-26; col 3, lines 60-65; col 14, lines 48-54).

Claim 73: Webber discloses a method as recited in claim 70, and further discloses the first business entity using the network to:
facilitate milestone-based project planning between the matched service provider and the manufacturer (col 17, lines 24-31; col 19, lines 9-26; col 3, lines 60-65; col 14, lines 48-54).

Claim 74: Webber discloses a method as recited in claim 70, and further discloses the first business entity using the network to:

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display the manufacturer offerings of the matched manufacturer to the matched service provider using the network, and display the services provided by the matched service provider to the matched manufacturer (col 19, lines 9-26).

Claim 75: Webber discloses a method as recited in claim 70, and further discloses that the information of the manufacturer includes information relating to the availability of the manufacturer offerings (col 20, lines 15-30; col 20, lines 50-65).

Claim 76: Webber discloses a method as recited in claim 75, and further discloses the first business entity using the network to:
notify the service provider of the availability of the manufacturer offerings that match a service installation (col 19, lines 9-26; col 3, lines 60-65; col 14, lines 48-54; col 17, lines 24-31).

Claim 77: Webber discloses a method as recited in claim 72 for milestone-based project planning during installation management in a network-based supply chain environment, and further discloses:

- (a) displaying on a display a pictorial representation of an existing service including a plurality of components (col 4, lines 60-61; col 8, lines 41-51; col 11, lines 28-34; col 14, lines 40-44);
- (b) presenting on the display a first set of components that are to be delivered for an installation in a first phase by indicia coding the first set (col 17, lines 24-31); and
- (c) presenting on the display a second set of components of the installation that are to be delivered for the installation in a second phase (col 17, lines 24-31; col 19, lines 9-26; col 3, lines 60-65; col 14, lines 48-54).

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Webber does not explicitly disclose that different indicia are used for different phases of the project.

~~Webber further discloses project management (col 3, lines 60-65; 14, lines 48-54), scheduling (col 17, lines 24-31), and customized display formats (col 16, lines 19-47) in order to streamline processes (col 16, lines 14-47). Webber further discloses custom symbols in order to make a document easier to read and utilize (col 16, lines 33-36).~~

However, Webber further discloses project management (col 3, lines 60-65; 14, lines 48-54), scheduling (col 17, lines 24-31), and customized display formats (col 16, lines 19-47) in order to streamline processes (col 16, lines 14-47). Webber further discloses custom symbols in order to make a document easier to read and utilize (col 16, lines 33-36).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to Webber's utilization of symbols or indicia to Webber's project management. One would have been motivated to do this because indicia or symbols allow a user an easy way to track different aspects of a project.

Claim 78: Webber discloses a method as recited in claim 77.

Webber does not explicitly disclose presenting a legend which defines the indicia coding with respect to the phases of delivery of the components.

However, Webber discloses project management (col 3, lines 60-65; 14, lines 48-54), scheduling (col 17, lines 24-31), and customized display formats (col 16, lines 19-47) in order to streamline processes (col 16, lines 14-47). Webber further discloses custom symbols in order to make a document easier to read and utilize (col 16, lines 33-36).

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Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add a legend to Webber's project management and the utilization of symbols in a document. One would have been motivated to do this because a legend is obvious in any document that utilizes special symbols.

Claim 79: Webber discloses a method as recited in claim 77, and further discloses that the components of the existing service are selected from the group of components including security services, network services, web services, client services, integration capabilities, data services, directory services, management services, operation services, and developer services (col 3, lines 60-65; 14, lines 48-54; Fig. 2; Fig. 4).

Claim 80: Webber discloses a method as recited in claim 77, and further discloses that the components of the existing service are selected from the group of components including commerce-related services, content related services, administration-related services, customer-related services, and education related services (col 3, lines 60-65; 14, lines 48-54; Fig. 2; Fig. 4).

Claim 81: Webber discloses a method as recited in claim 77.

Webber does not explicitly disclose that the indicia coding is selected from the group of indicia coding including texture coding, color coding, and shading coding.

However, Webber discloses customized display formats (col 16, lines 19-47) in order to streamline processes (col 16, lines 14-47). Webber further discloses custom symbols in order to make a document easier to read and utilize (col 16, lines 33-36).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add texture, color, or shading Webber's documents with specialized

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symbols. One would have been motivated to do this because texture, color, or shading are obvious ways to make something stand out in a document and to attain the attention of a reader.

6. Claims 82, 83, 84, 86 are rejected under 35 U.S.C. 103(a) as being unpatentable over Webber (6,167,378) in view of Abgrall (6,373,298).

Claim 82, 83, 84, 86: Webber discloses a method as in claim 70. Webber further discloses installing a service (col 16, lines 20-25) and project management (col 3, lines 60-65; 14, lines 48-54) and that users can buy goods or services or make specific requests (col 20, lines 15-21).

Webber does not explicitly disclose profiling a client user.

However, Abgrall discloses a method, program, and apparatus for displaying content to a user based on a profile (Abstract and col 3, lines 28-31). Abgrall further discloses identifying a user (col 8, lines 49-51; col 3, lines 8-11; and Fig. 1), collecting information about the user wherein the information relates to the installation of a service (col 3, lines 1-8), building a profile of the user based on the collected information (col 3, lines 10-15), managing a plurality of different contents (col 2, lines 23-33), analyzing the profile and the contents in order to match attributes of the profile of the user and attributes of the contents (col 9, lines 25-55), selecting the contents which have attributes that match the attributes of the profile of the user (col 9, lines 40-42), and delivering the selected contents to the user (col 9, lines 40-42).

Abgrall further discloses that the step of analyzing the profile occurs in real time (col 9, lines 50-55 and col 10, lines 20-29).

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Abgrall further discloses identifying a time when the user last viewed the contents, and indicating portions of the contents that have been modified or added since the time when the user last viewed the contents (col 3, lines 10-15; col 4, lines 26-31; col 11, lines 34-35; and col 10, lines 20-25).

Abgrall further discloses further discloses allowing the user to rate the contents (col 4, line 67-col 5, line 7 and col 10, lines 22-25).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Abgrall's profiling a client user to Webber's providing a service to a client user and allowing a client user to purchase goods or services. One would have been motivated to do this because profiling a client user who makes requests or purchases goods or services increases the likelihood of more efficient sales of goods or services to the client user.

7. Claim 85 is rejected under 35 U.S.C. 103(a) as being unpatentable over Webber (6,167,378) in view of Abgrall (6,373,498) in view of Gerace (5,991,735).

Claim 85: Webber and Abgrall disclose a method as in claims 82. Abgrall further discloses that the user is identified by receiving user input (col 4, line 67-col 5, line 7 and col 10, lines 22-25) and that digital signatures are used (col 9, lines 3-11).

Abgrall further discloses profiling the user utilizing a variety of means (col 3, lines 1-15), utilizing a website and downloaded software to assist in the user identification and profiling (col 4, lines 20-27; col 4, line 65-col 5, line 6), and that the system can utilize the Internet and websites (col 2, lines 35-45; col 2, lines 22-26).

Abgrall does not explicitly disclose the use of cookies to identify a user.

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However, Gerace discloses identifying a user and his preferences using cookies (col 13, line 59- col 14, line 2). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Gerace's utilization of cookies to Abgrall's user profiling and content delivery method, program, and system. One would have been motivated to do this so that Abgrall can track users utilizing a method common to the industry that provides ease of management when interacting with the Internet.

Response to Arguments

8. Applicant's arguments with respect to claims 70-86 have been considered but are moot in view of the new ground(s) of rejection.

Examiner notes that while specific references were made to the prior art, it is actually also the prior art in its entirety that is being referred to.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (703)305-4687. The examiner can normally be reached on Mon- Fri, 7:30-4:00.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (703)305-8469. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9326 for regular communications and (703)872-9327 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1113.

AO

August 1, 2003


James W. MYHRE
PRIMARY EXAMINER
ART UNIT 3622